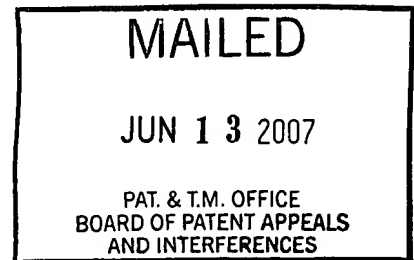


1 RECORD OF ORAL HEARING  
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3 UNITED STATES PATENT AND TRADEMARK OFFICE  
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5  
6 BEFORE THE BOARD OF PATENT APPEALS  
7 AND INTERFERENCES  
8  
9

10 Ex parte RAYMOND F. RATCLIFF III  
11  
12

13 Appeal 2007-1302  
14 Application 09/818,003  
15 Technology Center 2100  
16  
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18 Oral Hearing Held: May 9, 2007  
19  
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22 Before JAMES D. THOMAS, JOSEPH L. DIXON, and  
23 JEAN R. HOMERE, Administrative Patent Judges.  
24

25 ON BEHALF OF THE APPELLANT:  
26

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32 The above-entitled matter came on for hearing on Wednesday, May 9,  
33 2007, commencing at 9:08 a.m., at The U.S. Patent and Trademark Office,  
34 600 Dulany Street, Alexandria, Virginia.



1 JUDGE THOMAS: Good morning.

2 MR. LAZAR: Good morning.

3 JUDGE THOMAS: You've been here before, haven't you?

4 MR. LAZAR: Well, I have. Not recently though, not since the move  
5 to the new building.

6 JUDGE THOMAS: The rules are basically the same, you know. You  
7 have 20 minutes. You can use that clock as a guide.

8 MR. LAZAR: Okay, great.

9 JUDGE THOMAS: You may proceed at any time.

10 MR. LAZAR: Okay. Thank you very much. May it please the board,  
11 my name is Dale Lazar. I'm here on behalf of the inventor, Raymond  
12 Radcliff and the owner of this application, Hemisphere II.

13 Well, first, I guess, you hear a lot of this. We're in a post-KSR world  
14 with pre-KSR briefs. If I had a dollar for every time I mention suggestion,  
15 teaching or motivation in the brief, I think I'd be able to retire at this point.  
16 If you could read the word -- reason for suggestion, teaching or motivation  
17 in our briefs, I think the result comes out to the same whether we're talking  
18 pre-KSR or post. I think our invention is clearly patentable, and I hope to be  
19 able to establish that for you this morning.

20 The invention relates to a system for identifying a document. You're  
21 on a train reading a newspaper, you're in a library reading an article or a  
22 magazine somewhere and it's interesting to you and you think that it would  
23 be interesting to someone else.

24 How do you get that article to that other person? Well, you could tear  
25 out that article and physically get it to them, but that may not be a practical  
26 solution. You could scan the entire article with some sort of scanner and



1 send an electronic version of the article to the person you wish to have it be  
2 received by. But that is cumbersome if you're doing hand scanning. That's  
3 not such a great solution.

4 What Mr. Radcliff has come up with is a kind of a hybrid solution to  
5 this problem. What Mr. Radcliff suggests is that you do capture an image of  
6 at least a part of the document and you use that actual data from the  
7 document itself as an identifier of the document that can be sent to a  
8 computer or a server somewhere to actually represent the document.

9 Then that computer or server would compare the snippet of the article  
10 whose image was captured with the database and look for that article in the  
11 electronic database. And then that electronic article from the database could  
12 be sent to the intended recipient in a much higher form than would be the  
13 case if you actually just scanned the whole document.

14 So that's the essence of the invention.

15 We can start with Claim 1. Claim 1 of the application talks about a  
16 method for sending information to a data processing system for  
17 identification of a document. The body of the claim talks about providing  
18 the document and capturing information from the document where the  
19 information comprises actual data from the document.

20 So somehow we're capturing data from the document, either by  
21 scanning maybe the title of the document and the date or the journal cite for  
22 it or the first few lines of the document, or perhaps using a digital camera to  
23 capture that information, somehow capturing information about the  
24 document where that information comprises actual data from the document.  
25 That's an important limitation.



1           Storing the captured information, establishing a communication path,  
2   retrieving the document from the memory of the handheld device and then  
3   sending the retrieved information to the data processing apparatus through  
4   the communications path for identification of the document.

5           So we're using -- we're capturing with a handheld device actual data  
6   from the document and using that to identify the document. This claim,  
7   Claim 1, was rejected over the combination of a patent to Eldridge and a  
8   patent to Neukermans.

9           Eldridge talks about a data processing system that employs tokens to  
10   reference a document or a server. Well, what's a token? A token, according  
11   to Eldridge, is or contains information about an operation to be performed,  
12   the address of the document, parameters, defining the property of the  
13   document, perhaps the visible name of the document, and then security  
14   parameters.

15          The idea here is that if you send tokens through the system rather than  
16   the document itself to cut down on the volume of data that needs to be  
17   transmitted. So if a computer wants to -- if a command comes to a computer  
18   to have a document printed, that computer would generate a token and the  
19   token would be sent to the printer.

20          The printer would look at the token and understand that it is to print  
21   three copies of this document, for example. It would know the identity of  
22   the document and where to retrieve the document from. There would be  
23   security parameters also to make sure that all of this happens in a secured,  
24   controlled sort of environment. And then the printer would do what it was  
25   told to do in accordance with the token.



1           The examiner agrees that Eldridge never contemplated the idea of  
2 including actual data from the document itself in the token, okay.

3           JUDGE THOMAS: Let's clarify something. The only feature of  
4 Claim 1 that's not in Eldridge allegedly by the examiner is the capture  
5 capability?

6           MR. LAZAR: It's two things. Well, I think the examiner would --  
7 hard to say what the examiner would think, but from my perspective  
8 anyway, Eldridge does not suggest capturing actual data from the document  
9 itself. And then I think the examiner would agree that Eldridge does not  
10 teach using that actual data to identify the document. It goes hand in hand.

11          JUDGE HOMERE: I'm trying to figure out what this -- capturing  
12 information from the document, what that actual entails. It appears to me --  
13 I guess maybe I should put the question to you: Would capturing the  
14 information from the document be something that for instance, you're  
15 reading the newspaper and then you write down on a piece of paper, you  
16 write down or copy a portion of it and then you key it into for instance your  
17 telephone functions, your mobile phone. Would that be capturing?

18          MR. LAZAR: Not in the context of this invention and the claim.  
19 This requires a handheld device.

20          MR. HOMERE: But the claim doesn't say that you're capturing the  
21 information using the handheld device, does it?

22          MR. LAZAR: In the preamble it does, yes, using a handheld device  
23 capable of communication with the data processing apparatus and then  
24 storing the captured information in the handheld device as document data.

25          JUDGE HOMERE: -- the method for sending information using the  
26 handheld device, but it doesn't say that you're actually capturing information



1 using the handheld device. So any way you can capture that information  
2 would do based on what I'm seeing here, right?

3 MR. LAZAR: Yes, I suppose that's right.

4 JUDGE HOMERE: Okay. Thanks.

5 MR. LAZAR: I suppose that's right. It's not what was intended, but I  
6 think you're right.

7 JUDGE HOMERE: Okay. Thanks.

8 JUDGE THOMAS: So if there's a teaching in Eldridge that suggests  
9 that the capturing capability otherwise was already done somewhere else, is  
10 it your admission now that the capturing feature of the claim would have  
11 been taught by Eldridge?

12 MR. LAZAR: No. No, because there's no suggestion in Eldridge --  
13 first of all there's no suggestion of including this captured information as an  
14 identifier of the document.

15 JUDGE THOMAS: So that's another feature?

16 MR. LAZAR: Well, right. I think we're saying the same thing over  
17 and over again, but I would say it's the same feature.

18 JUDGE THOMAS: So the real definitive feature that you're arguing  
19 is the wherein clause of the information comprising actual data from the  
20 document?

21 MR. LAZAR: That, coupled with that "actual data being used to  
22 identify the document at the very end of Claim 1."

23 JUDGE THOMAS: Okay.

24 MR. LAZAR: And I think the telling part of Eldridge is at column  
25 one, lines 35 through 37 where it says that "documents are effectively  
26 distributed by tokens rather than the lengthy document itself." The whole



1 point of Eldridge is to get rid of the document, to transmit tokens through the  
2 system rather than the document itself.

3 Neukermans is just a hand scanner. It's a device capable of scanning  
4 and storing a document. And we acknowledge that certainly we weren't the  
5 first to scan documents by hand.

6 JUDGE HOMERE: Let me suggest something to you for a moment.  
7 You say that the primary reference is the tokens. You get a piece of token  
8 and then you send information -- which you use to send information to the  
9 printer, right?

10 MR. LAZAR: Correct.

11 JUDGE HOMERE: And you get to the printer to technically print  
12 something out, right? Okay. Now would it not be reasonable to construe  
13 that the token itself has information about something?

14 MR. LAZAR: It has information about the document, no question. It  
15 has identifying information.

16 JUDGE HOMERE: Exactly, yes. Now how the information gets into  
17 the token we don't know. Now couldn't that be construed as information  
18 that's embodied that's stored in the token as information that has been  
19 captured?

20 MR. LAZAR: No. At least there's no suggestion of that in Eldridge.  
21 If you read Eldridge from stem to stern, Eldridge identifies five things as  
22 being in --

23 JUDGE HOMERE: No, no. What I'm saying -- I'm looking at this  
24 from the standpoint of one -- I'm saying that you have a token, right? And  
25 the token itself has information that you're going to be forwarding to a  
26 printer in order for the printer to print something, right?



1 MR. LAZAR: Right.

2 JUDGE HOMERE: So I'm saying that since the token itself has  
3 information in it, therefore that information must have been captured  
4 somehow. Someone might have put it in there, because the claim doesn't  
5 say that you're actually using the handheld device to capture it and put it in a  
6 token. So somehow you got the information in the token, right?

7 MR. LAZAR: But the information in the token is not captured from  
8 the document itself.

9 JUDGE HOMERE: It's captured from a document?

10 MR. LAZAR: It is identifying information that identifies the  
11 document.

12 JUDGE HOMERE: -- a document, right?

13 MR. LAZAR: The document, yes, a document, and where it's stored.

14 JUDGE HOMERE: And therefore that information -- what is it?

15 MR. LAZAR: And where it's stored.

16 JUDGE HOMERE: Yes, therefore that information must have been  
17 captured in order for it to be in the token.

18 MR. LAZAR: But not from the document itself. It isn't actually data  
19 from the document. It's abstracted from the document perhaps, but it isn't  
20 the document itself.

21 JUDGE HOMERE: But the claim does not require that their  
22 document itself be captured. It requires that information from the  
23 document --

24 MR. LAZAR: No, actual data from the document is the information,  
25 actual data from the document.



1 JUDGE HOMERE: Yes, but it doesn't have to be the whole  
2 document. It only requires a portion of the document. It could be the data,  
3 right? So for all that we know the token itself could be just the page, if we're  
4 going to relate it to a page in the document to be printed out.

5 MR. LAZAR: I agree that it doesn't have to be the entire document.

6 JUDGE HOMERE: Oh, all right.

7 JUDGE THOMAS: So what's the scope of teaching in Eldridge of  
8 token?

9 MR. LAZAR: The whole point of the token in Eldridge is to  
10 eliminate the actual document, as suggesting in column one of Eldridge.

11 JUDGE THOMAS: Well, I'm asking for you to tell me what you  
12 think Eldridge teaches as to what is a token.

13 MR. LAZAR: Eldridge teaches --

14 JUDGE THOMAS: Can Eldridge's token be a part or any label  
15 derived from information on the document itself like a whole page or a title  
16 or a publisher or a cite from like the Washington Post, you know, that gives  
17 you the date and the edition and all that stuff?

18 MR. LAZAR: No suggestion of that in Eldridge. You wouldn't, of  
19 ordinary skill in the art, reading Eldridge you would not understand that.  
20 Eldridge limits the token to the five things that I've previously mentioned,  
21 none of which you've mentioned.

22 JUDGE THOMAS: What are the five things again, please?

23 MR. LAZAR: The operation to be performed on the document, the  
24 address of the document in the data processing system, a parameter defining  
25 a property of the document, the visible name and security parameters.



1           Our view is that it wouldn't be obvious to combine Neukermans with  
2 Eldridge. There is a teaching away here. The whole point Eldridge teaches  
3 us that the system -- that Eldridge wants the system to transfer tokens around  
4 the system to avoid the lengthy document itself.

5           JUDGE THOMAS: Do you argue teaching away in the briefs?

6           MR. LAZAR: Yes.

7           JUDGE THOMAS: Okay.

8           MR. LAZAR: Yes, whereas Neukermans is intended to capture the  
9 entire document itself and store the document itself and transmit the  
10 document itself.

11          JUDGE THOMAS: So what happens if Neukermans is a good  
12 reference by itself to reach Claim 1?

13          MR. LAZAR: Neukermans has nothing to do with identifying the  
14 document. You've captured the document itself. There's no suggestion of a  
15 database. There's no suggestion of sending that information to identify the  
16 document.

17          JUDGE THOMAS: Well, let's -- is that the only distinction that you  
18 feel Neukermans has as to Claim 1?

19          MR. LAZAR: As to Claim 1.

20          JUDGE THOMAS: All right. The preamble talks about for  
21 identification of the document, does it not?

22          MR. LAZAR: Yes.

23          JUDGE THOMAS: And so does the last few words of the claim,  
24 right?

25          MR. LAZAR: Right.



1 JUDGE THOMAS: But there's no stated step that does the ID in the  
2 claim?

3 MR. LAZAR: That is true. We're sending it for identification though.

4 JUDGE THOMAS: So how are we supposed to treat those words?  
5 For identification is the desired end result for which there's no recited step  
6 that achieves it.

7 MR. LAZAR: Well, the sending -- that's a good point. Claim 12  
8 overcomes that by also requiring the steps of comparing the scanned  
9 information, the actual data from the document with documents in the  
10 database and selecting one of the documents in the database that makes the  
11 scanned data.

12 JUDGE THOMAS: So are you going to still maintain that Claim 1 is  
13 patentable on Neukermans alone?

14 MR. LAZAR: Yes, because I think that the sending step is for the  
15 specific purpose of identifying the document, and that is not done in  
16 Neukermans or Eldridge for that matter. So that's really the heart of the  
17 argument.

18 The client, the invention --

19 JUDGE THOMAS: I'll give you some more time. Just don't worry  
20 about the clock, okay.

21 MR. LAZAR: The heart of the -- the essence here is that we're  
22 capturing actually data from the document that's used to identify that  
23 document.

24 JUDGE THOMAS: And that's the major theme of your arguments?

25 MR. LAZAR: Right. You have Eldridge and Neukermans, which  
26 point in different directions in terms of a teaching away sort of thing where



1 you have Eldridge saying in the patent itself that the point of the tokens is to  
2 avoid the lengthy document whereas Neukermans captures the lengthy  
3 document.

4 It wouldn't be obvious to put those together. Even if you did, you still  
5 aren't creating a system that captures actual data from the document to  
6 identify that document. Neukermans captures the document to be the  
7 document rather than to identify the document.

8 JUDGE HOMERE: Counselor, you said that one of the five things  
9 that the token can hold is parameters of the document?

10 MR. LAZAR: Yes. Rather undefined in Eldridge as to what those  
11 parameters are, but it's --

12 JUDGE HOMERE: So it's parameters, the location of the  
13 document -- parameters, location of document and what were the other  
14 three?

15 MR. LAZAR: Operation to be performed.

16 JUDGE HOMERE: Okay.

17 MR. LAZAR: The name and the security parameters.

18 JUDGE HOMERE: Okay. Let's stick with the parameters and the  
19 name of the document. Would the name of the document itself be data,  
20 actual data from the document? Can that be construed as actual data from  
21 the document?

22 Like say for instance you have a newspaper article entitled KSR  
23 Versus Deltaflex, for instance, and then somehow in the token itself you get  
24 that information in there, could that be construed as -- because it says that  
25 one of the types of information it can include in the token is the name of the



1 document. Could that be construed as actual data from the document that's  
2 being sent to the burner?

3 MR. LAZAR: The visible name is abstracted from the article, but  
4 whether that visible name matches anything that actually is in the document  
5 itself is up to the abstracter. It depends on what you want to put into the  
6 token. It does not necessarily need to be what is actually in the document  
7 itself.

8 JEAN HOMERE: Yes, but the name of the document could be the  
9 title of the document, for instance, as you said.

10 MR. LAZAR: It could be, but it doesn't have to be. It's not captured  
11 from the document itself; it's whatever the abstracter wants to put into the  
12 token.

13 JUDGE HOMERE: Why does it appear to me that Eldridge by itself  
14 appears to teach all the -- limitations of Claim 1, this another interpretation  
15 of what the token is doing?

16 MR. LAZAR: Because Eldridge doesn't teach capturing that  
17 information from the actual data of the document itself.

18 JUDGE HOMERE: Notwithstanding the fact that it teaches a  
19 token -- include the name, the name of the document?

20 MR. LAZAR: That may or may not be from the document itself. It  
21 may be completely made up the abstracter.

22 JUDGE HOMERE: Okay.

23 JUDGE THOMAS: To the extent it is the actual name of the  
24 document done by the abstracter how do you see that?

25 MR. LAZAR: There's no requirement in Eldridge that it has to be  
26 there. You're putting more into Eldridge than what's there. This token is



1 not -- is created by whoever is operating the system, if not done  
2 electronically by the system itself.

3 JUDGE THOMAS: Well, how is the ordinary skilled person going to  
4 view that teaching about Eldridge?

5 MR. LAZAR: I think that person would not -- would realize and the  
6 examiner accepts the fact that the token in Eldridge does not include actual  
7 data from the document itself.

8 JUDGE HOMERE: So you're saying that when I was -- I would have  
9 not known that a name is -- can be construed as a title, for instance, of a  
10 document?

11 MR. LAZAR: It can be, but there's no requirement is Eldridge that it  
12 does be, if you will.

13 JUDGE HOMERE: Yes, but I'm saying, but for one skilled in the art,  
14 having that information before them, would that person readily recognize  
15 that, well, you know, I have a title before me or I have a name of a document  
16 before me, then that information is -- the name is the same thing as the title,  
17 therefore, you know, that's from the document, therefore it's actual data from  
18 the document.

19 MR. LAZAR: But there's no requirement that that title come or the  
20 name come from the document itself. It can be a name given to the  
21 document by the system creator.

22 JUDGE DIXON: Does that matter?

23 MR. LAZAR: Yes, I think it does matter.

24 JUDGE DIXON: We have a method here with a sequence of steps  
25 and if in one of those situations the sequence of steps is met the claim is met.  
26 It doesn't need to do it in all situations. You haven't recited a machine which



1 is doing this and has to do it all the time. You have a sequence of steps that  
2 are met, and if that meets it, the claim is met under 102.

3 I mean yes, you can say it's not taken from the specific document. If  
4 somebody reads it and they type it in, it is there. Providing a document they  
5 have at that point captured the information from the document, put it in their  
6 hand, typed it in wherein the information comprised actual data from the  
7 document -- you didn't say you scanned it.

8 If you did, his interpretation is out, then unless then you're going to  
9 say that the person had to scan it, which arguably -- one skilled in the art -- a  
10 scanner would do that also. But it meets the claim limitations. I understand  
11 your situation. It doesn't do it in all. You don't have 'all' in there. One  
12 situation meets it; arguably you've got a 102.

13 It seems like under either reference according to the two judges --

14 MR. LAZAR: I understand what you're saying.

15 JUDGE DIXON: Maybe Claim 12 is a better claim to differentiate,  
16 but --

17 MR. LAZAR: Well, Claim 12 certainly does and Claim 16 even goes  
18 farther than Claim 12 in differentiating from these references.

19 I, to be perfectly honest, have been operating under the believe that  
20 the capturing was by the handheld device. I see what you're saying about  
21 the fact that it isn't. It would certainly make the case stronger if --

22 JUDGE DIXON: Or if it was structured as an apparatus claim doing  
23 the method somehow, yes inferentially maybe you could interpret it that  
24 way. Here it doesn't seem like it's an unreasonable interpretation.



1           If it meets it in one step, one interpretation, granted, yes, there are  
2 other interpretations, but we don't have to meet it all, we have to meet it  
3 once.

4           MR. LAZAR: If you look at the preamble though, the preamble talks  
5 about a method of sending information to a data processes system for  
6 identification of a document.

7           JUDGE DIXON: That's the sending, and it would do that.

8           MR. LAZAR: Right.

9           JUDGE DIXON: Once you put it in it would be sent.

10          MR. LAZAR: Right.

11          JUDGE DIXON: It was from the document, but it was captured in a  
12 different manner.

13          MR. LAZAR: having the information -- a document having the  
14 information. Using a handheld device --

15          JUDGE THOMAS: The sending function is by using.

16          MR. LAZAR: I see what you're saying.

17          JUDGE THOMAS: Are you ready to concede patentability of  
18 Claim 1?

19          MR. LAZAR: No. I don't think so. I still stand by the fact that the  
20 capturing of the actual data from the document is something that is not  
21 taught in Eldridge. The examiner and we are in agreement on that.

22          JUDGE DIXON: But you wouldn't have heartburn if we were to  
23 make our own finding?

24          MR. LAZAR: Well, I certainly would know how to fix Claim 1 to  
25 make your finding more challenging.

26          MR. HOMERE: Do you have anything else?



1           MR. LAZAR: No, that's it. Claim 12 gets into comparing and  
2 selecting. Claim 16, then, you actually provide an address of the  
3 information of the recipient to receive the information, and once you select  
4 the document out of the database you then send the document, the actual  
5 electronic document to the intended recipient using the address information  
6 moving further and further away from Eldridge and Neukermans.

7           JUDGE HOMERE: Thank you very much.

8           MR. LAZAR: Okay. Thank you very much.

9           JUDGE HOMERE: Thank you.

10          JUDGE THOMAS: Have a good day.

11  
12          (Whereupon, the proceedings concluded.)